

**REMARKS**

Claims 1-21 were examined in the Office Action under reply. Applicants note with appreciation the withdrawal of the previous rejections under 35 U.S.C. §112, second paragraph. However, the Office maintained the rejection of claims 1-21 under 35 U.S.C. §103(a) as follows:

- (1) Claims 1-5, 10, 11, 13-15 and 17-19 remain rejected over U.S. Patent No. 6,352,862 to Davis et al. (“Davis”), in view of U.S. Patent No. 6,274,323 to Bruchez et al. (“Bruchez”);
- (2) Claims 6, 7, 12, 16 and 20 remain rejected over Davis and Bruchez and further in view of U.S. Patent No. 6,444,143 to Bawendi et al. (“Bawendi”);
- (3) Claims 8 and 9 remain rejected over Davis and Bruchez, in view of Bawendi and further in view of U.S. Patent No. 5,990,479 to Weiss et al; and
- (4) Claim 21 remains rejected over Davis and Bruchez in view of U.S. Patent No. 6,372,514 to Lee et al.

These rejections are maintained for reasons of record. Applicants respectfully traverse.

All of the above combinations rely on Bruchez. However, pursuant to 35 U.S.C. §103(c), Bruchez is disqualified as prior art since the subject matter of Bruchez and the claimed invention were, at the time the inventions were made, owned by the same person or subject to an obligation of assignment to the same person. See, MPEP §706.02(I)(1). To evidence common ownership, applicants are submitting the Declaration of Kenneth Barovsky, Vice President and Intellectual Property Counsel of the assignee of this application and of the Bruchez patent. The Declaration includes the statement considered sufficient evidence to establish common ownership of, or an obligation for assignment to, the same organization. See, MPEP §7.06(I)(2)(II). Thus, for this reason alone, the above bases for rejection should be withdrawn.

Nevertheless, applicants are also providing a Supplemental Declaration of Inventorship as the Office asserted that the previous Declaration of Inventorship was not sufficient to remove Bruchez as a reference. The Supplemental Declaration satisfies the requirements of MPEP §706.02(k)(C). Thus, the Bruchez patent is not “an application for patent by another” and is therefore not properly citable art against the present application. Withdrawal of the above bases for rejection is therefore respectfully requested.

Atty Dkt No. 5100-0005

USSN: 09/750,223

PATENT

Applicants are also submitting a Request to Correct Inventorship under 37 CFR §1.48(a), along with the documents required by 37 CFR §1.48(a), in order to add Marcel P. Bruchez as an inventor on the present application.

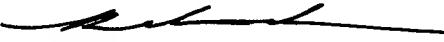
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**CONCLUSION**

Applicants respectfully submit that the claims define a patentable invention. Accordingly, a Notice of Allowance is believed in order and is respectfully requested. If the Examiner notes any further matters which he believes may be resolved by a telephone interview, he is encouraged to contact the undersigned by telephone at 650-493-3400.

Respectfully submitted,

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